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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/717,090

11/20/2003

Taku Kodama

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7016

22850 7590 10/19/2007

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EXAMINER

DANG, DUY M

ART UNIT

PAPER NUMBER

2624

NOTIFICATION DATE

DELIVERY MODE

10/19/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/717,090

Applicant(s)

KODAMA ET AL.

Examiner

Duy M. Dang

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-205 is/are pending in the application.
- 4a) Of the above claim(s) 40-205 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of invention of Group I, claims 1-39 in the reply filed on 8/2/07 is acknowledged. The traversal is on the ground(s) that "PTO has not carried forward...undue burden" (see page 1) and "The claims of the present invention...serious burden" (see page 2). This is not found persuasive because of the reasons as follows:

-It is noted that "*Restriction is a practice of requiring an application to elect a single claimed invention (e.g., a combination or subcombination invention, a product or process invention, a species within a genus) for examination when two or more independent inventions and/or two or more distinct inventions are claimed in an application.*" See MPEP 802.02. Furthermore, "*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*" See 35 USC § 101. In this case, the instant application does not contain a single claimed invention, thus applicant is required to elect a single claimed invention.

-Furthermore, search and examination is different from each invention. For example, search and examination for "setting thumbnail information in one or a plurality of form and adding such forms of thumbnail to a header portion of the compressed code data upon" Invention of Group II are not required in search and examination for Inventions of Groups I and III-IV; search and examination for "an information processing apparatus and method for producing compressed code data comprising storage location and information concerning a location storing the image to be compressed" Invention of Group III are not required in search and examination

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for Inventions of Groups I-II and IV; and search and examination for “an information processing apparatus and method comprising extracting desired code data from image code data and adding information concerning the extracted desired code” Invention of Group IV are not required in search and examination for Inventions of Groups I-III. Moreover, there may be part of an overlapping search area, but there is not all overlapping search area. The examiner acknowledges that electronic search is commonly performed, but it performs differently for divergent claimed features.

-In addition, each inventions of Groups I-IV has a different status of classification, such restriction is required. Otherwise, the U.S. Patent Classification would have not been existed.

-Lastly, this particular application contains 184 pages of specification, 57 pages of drawings in 62 figures, and 205 claims in 82 pages, there is a serious burden in search and examination the inventions.

Thus, there is a serious burden for search and examination for the instant application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 40-205 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions of Groups II-IV, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/2/07.

3. The invention of Group I elected, claims 1-39 of the present application contains claims directed to the following patentably independent or distinct species: Species 1, corresponding to claims 2-12, 21-29, and 36-39; and Species 2, corresponding to figure 12 and claims 30-35.

4. The species 1-2 are independent or distinct because:

(i) Each of species 1-2 has a different characteristics or utility for each identified species.

For example, the utility directed in Species 1 is not used in of Species 2 and vice versa; and

(ii) These species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, generic claims are claims 1 and 20.

There is an examination and search burden for these patentably distinct species due to their independent or distinct characteristics, or utility. The species requires a different field of search; and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 USC 101 and/or 35 USC 112, first paragraph.

Applicant is advised that a reply to this requirement to be complete must include an election of species to be examined even though the requirement may be traversed (37 CFR 1.143). An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In neither instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd
10/07


DUY M. DANG
PRIMARY EXAMINER